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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/842,680	04/15/1997	AMIRAM STEINBERG	1582/53112	5493

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EXAMINER

ISABELLA, DAVID J

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
08/842,680

Applicant

STEINBERG

Examiner
ISABELLA, DAVID J.

Group Art Unit
3738

☒ Responsive to communication(s) filed on Jul 13, 1999

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-56 is/are pending in the application.

Of the above, claim(s) 4-7, 21-34, 38-48, and 50-56 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-3, 8-20, 35-37, and 49 is/are rejected.

☐ Claim(s) _____ is/are objected to

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "10" and "3" have both been used to designate the implant. Correction is required.

Claim Rejections - 35 USC § 112

2. Claims 1-3, 8-20, 35-37 and 49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite. There is no structural nexus between the interface portion and the support structure. There is no structure defining an "interface".

Claim 2 is indefinite. Claim 1 fails to positively set forth a structure defining the implant and therefor, there is no support for the "central core".

Claim 3, recitation of "truss-like" is indefinite for failing to positively limit the same.

Claim 9 should recite the implant having a surface defining a bone engaging interface and the interface comprises a plurality of support elements protruding therefrom.

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Claim 10 is indefinite. It is not clear what characteristic is being adapted for fit within a bone canal.

Claim 11 is redundant to claim 9.

Claim 12, there is no physical nexus between the cable and the support structure.

Claim 13, there is no physical nexus between the cable, the bridge element and the support structure.

Claim 14, see claim 12 supra.

Claim 15 is indefinite. It is not clear how and by what means asymmetric tension is effected to the cables.

Claim 16 should positively recite the cables as having means for adjustment before, during, and/or after.

Claim 17 fails to further define the structure of claim 14.

Claim 18 should recite that the medication is administered after implantation in the bone.

Claim 19 is indefinite. It is not clear if the medication and the coated material are one and the same.

Claim 20 is indefinite for the improper alternative language. BMP and medication are not equivalent elements.

Claim 35, see rejections to claims 1 and 9 supra.

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Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1,2,8,9,10,11 and 35-37 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by either of Day or Weber. .

Each of Day and Weber disclose an implant comprising an interface portion and a central portion wherein the interface portion is deformable upon insertion into a prepared bone canal.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 18,19,20 are rejected under 35 U.S.C. 103(a) as being unpatentable over either of Day or Weber as applied to claim 1 above, and further in view of Muller-Lierheim.

The coating of implant surfaces with growth factors to enhance biocompatibility is taught by Muller-Lieheim. To coat the implant of Day or Weber with growth factors for increase tissue compatibility would have been obvious from the teachings of Muller-Lierheim.

7. Claims 1,3 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dumbleton, et al in view of Day.

Dumbleton, et al discloses an implant comprising an interface and a support core. The support core comprising a plurality of rods. Day teaches the use of an implant having an interface formed with deformable elements for better fixation into the prepared bone. To form the interface of Dumbleton, et al with deformable elements for better fixation to the bone would have been obvious from the teachings of Day.

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Election/Restriction

8. Claims 4-7,21-34,38-48,50-56 withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected invention and species. Election was made without traverse in Paper No. 10.
9. Applicant's election without traverse of claims 1-3,8-20, 35-37 and 49 in Paper No. 10 is acknowledged.

Allowable Subject Matter

10. Claims 12-17 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Isabella whose telephone number is (703) 308-3060. The Examiner's Supervisor, Mickey Yu, may be reached at (703) 308-2672. The group receptionist may be reached at (703) 308-0858.

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Should Applicant wish to send a fax for official entry into the file wrapper the Group fax number is (703) 308-3590. Should Applicant wish to send a fax for discussion purposes only, the art unit fax number is (703) 308-2708.



DAVID J ISABELLA

PRIMARY EXAMINER

GROUP 3700

dji

August 28, 1999